

REMARKS

Claims 1, 2, 4, 5, 8-18, 20 and 22 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject application is respectfully requested in view of the following comments.

It is respectfully requested that the finality of the Office Action dated July 6, 2002 be removed since the Examiner did not fully address the arguments submitted in the previous Reply to the Office Action dated December 14, 2001 and in addition to the following reasons provided herein.

I. Rejection of Claims 1, 2, 4, 5, 8-18, 20 and 22 under 35 U.S.C. §103(a)

Claims 1, 2, 4, 5, 8-18, 20 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Barclay *et al.* (5,960,399). Withdrawal of this rejection is respectfully requested for at least the following reasons. Barclay *et al.* does not teach or suggest the subject invention as claimed.

Independent claims 1, 12, 18, 20 and 22 recite in part: a host computer communicating a GUI file to a mobile terminal, the GUI file having attached thereto a dictionary file having ***phonemes*** and a syntax file having allowable patterns of words being content specific to the graphical display file.

Barclay *et al.* does not teach or suggest ***communicating*** a dictionary file having ***phonemes*** from ***a host computer to a mobile device***. As previously noted by the Examiner, the background of Barclay discusses employment of Hidden Markov Models (HMMs) and phonemes to ***decode*** speech. However, the Examiner ***did not*** address the previous arguments submitted, wherein not only are vocabularies downloaded to the mobile device, but, the speech decoding mechanisms themselves - such as phonemes which are recited in the respective claims, are also downloaded in order to facilitate decoding of the downloaded words and phrases. Since the background of Barclay (cols. 1-3) only addresses downloading words and phrases such as "Show me the weather in Boston," it can only be assumed from the teachings of Barclay (the background) that the mechanisms for decoding such speech are already ***resident*** on the ***client machine*** – thus defeating one of the motivations behind the present invention as recited in the claims. This is further highlighted in col. 3, lines 6 and 7 of Barclay that requires the speech recognizer software to reside at the client. The only further teaching in Barclay as to what may be downloaded is grammar specific to words and phrases ***only*** (See col. 3 lines 10-17).

Moreover, it is respectfully submitted that the Examiner has failed to establish a *prima facie*

case of obviousness for at least the following reasons: **A)** not considering and/or proving each and every limitation of the recited claims; **B)** improperly combining elements within a reference without a proper showing of evidence for combining such elements as required by established case law.

A. *The Reference Does Not Teach or Suggest All of the Claimed Limitations*

Barclay *et al.* does not teach or suggest all of the limitations recited in the rejected claims.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *Leinoff v. Louis Milona & Sons, Inc.*, 726 F.2d 734, 1984, 220 U.S.P.Q. (BNA) 845 (Fed. Cir. 1984); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), *see also In re Greene*, 1994 U.S. App. LEXIS 5103 (Fed. Cir. Mar. 17, 1994) ([T]his court gives meaning, where reasonably possible, to each term of a claim) *citing In re Wilson*.

In particular, with regard to the instant application, applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness and instead, has improperly determined patentability by misstating the teachings of Barclay *et al.* in general, and further, improperly combining portions thereof with respect to the claimed invention.

As noted in the previous Reply to the Office Action dated December 14, 2001, storing additional data for decoding speech as suggested in Barclay would defeat at least one of the purposes of the subject invention which is to mitigate the amount of memory and processing requirements in the mobile device. Since Barclay only teaches that words and phrase are downloaded and not the speech decoding mechanisms such as phonemes, it is respectfully submitted that a *prima facie* case of obviousness has not been established and therefore, the rejection of independent claims 1, 12, 18, 20 and 22 (and the claims that depend therefrom) should be withdrawn.

B. *The Examiner Has Improperly Combined Elements and References Without a Proper Showing of Evidence for Such Combination*

As noted by the court in *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988),

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. *See In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785,

787-87 (Fed. Cir. 1984). It can satisfy this burden **only by showing** some objective teaching in the prior art **or** that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

The Examiner has failed to provide any evidence within the reference itself or evidence showing that one of ordinary skill in the art would be motivated to select the combination recited in the subject claims. Furthermore, as recently stated in *In Re Kotzab*, 217 F. 3d 136 (Fed. Cir. 2000):

A rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

In particular, the Examiner has not provided any evidence or motivation why any of the elements taught in the background of Barclay would be combined with any other non-related elements that may happen to appear within Barclay. The subject invention as recited in the claims, discloses that the amount of data to be stored at the mobile device and associated data processing is mitigated by downloading not only dictionary and syntax files but speech decoding mechanisms such as phonemes as well. Nowhere in Barclay is such motivation or teaching found to combine the disparate elements cited by the Examiner that supposedly teach the combination recited in the subject claims of the present invention. The suggested combination of elements within Barclay appears to be based on improper hindsight, in which the Examiner has selected and combined individual features from the prior art, not based on a teachings from the references themselves, but instead based on employing the subject claims as a roadmap.

“It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, **in the prior art**, to combine the elements.” *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) (emphasis added).

In view of the above, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness based on the cited reference. Accordingly, the rejection of independent claims 1, 12, 18, 20, and 22 (and the claims which depend respectively therefrom) should be withdrawn.

II. Conclusion

The present application is believed to be in condition for allowance in view of the above comments.

If any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
AMIN & TUROCY, LLP



Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24th Floor, National City Center
1900 E. 9th Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731